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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,327	06/27/2002	Remi Deh	09669/021001	1726
22511	7590	04/21/2005	EXAMINER	
OSHA LIANG L.L.P. 1221 MCKINNEY STREET SUITE 2800 HOUSTON, TX 77010			CHEA, PHILIP J	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/069,327

Applicant(s)

DEH ET AL.

Examiner

Philip J Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/27/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

Claims 1-14 have been examined.

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. France 99 10747, filed on 8/24/1999.

### *Information Disclosure Statement*

2. The information disclosure statement (IDS) submitted on 6/27/02 was filed. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### *Claim Objections*

3. Claim 4 is objected to because of the following informalities: "MSSEEQ2" is apparently "MSSEQ2". Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. There is insufficient antecedent basis for the limitations of the claims below.  
  
As per claim 1, line 6, it is unclear which server is being addressed since the same label is used to identify the server line 2.

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As per claims 4 and 5, line 1, it is unclear which server is being addressed since the same label is used to identify the server in Claim 1, line 2.

As per claim 9, lines 6,7 and 9 it is unclear which server is being addressed since the same label is used to identify the server in line 2.

As per claim 10, line 2, it is unclear which server is being addressed since the same label is used to identify the server in Claim 9, line 2.

As per claim 12, line 2, it is unclear which server is being addressed since the same label is used to identify the server in Claim 9, line 2.

All other claims not mentioned specifically are rejected by virtue of being dependent on a rejected claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3,5,7,8 rejected under 35 U.S.C. 102(b) as being anticipated by Lisimaque et al. (WO 98/09257).

9. Examiner realizes that this reference was used in international preliminary examination report Application No. PCT/FR00/02343, and that the requirements of novelty were met for Claim 1. However, the Examiner disagrees with support from the reference.

As per claim 1, Lisimaque et al. disclose a device to load commands of a service in a computer system including at least one server (SERV) and at least one integrated circuit card (CARD) connected together via a network, the said card including a first command execution program (PI) and a first memory (M1), wherein,  
firstly, a card (CARD) includes:

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- means to search for a sequence block (B) capable of searching on a server (SERV) or in said memory (M1) a command sequence block specific to a service (see page 21, lines 1-8, where it is implied that the card has to perform some kind of search operation to recognize if the application selected is not initialized or present; further application being located in non-volatile memory, page 10, lines 21-23), for at least one command (CD) of said block (B) being executed by the first execution program (P1) [see page 12, lines 4-9, where execution program is maintained by a virtual machine] or transmitted to a subscriber unit (SU) and executed by a second execution program (P2) of this subscriber unit (SU),

and secondly, the said server (SERV) includes:

- means (ML) to load in the card at least one block (B) of a sequence (SEQ) of commands, specific to a service (S) [see page 21, lines 18-21, where loading in an entire application implies at least one command sequence block].

As per claim 2, Lisimaque et al. further disclose that the first memory is non volatile (see page 10, lines 21-23).

As per claim 3, Lisimaque et al. further disclose that the card includes a second non volatile memory (M2) including data specific to at least one service (see page 10, lines 16-19, where the operating system implies including data specific to at least one service when the service is running).

As per claim 5, Lisimaque et al. further disclose that a server includes means (MU) capable of modifying, erasing, adding, in the first memory (M1) at least one sequence block (B) [see page 16, lines 1-8, where modifying is considered the refreshed use rights].

As per claim 7, Lisimaque et al. further disclose that the card includes data request means (RD), the said data being sent by a service center (see pages 20 and 21, lines 21-23 and 1-21).

As per claim 8, Lisimaque et al. further disclose that the card includes means of interpreting (MI) command sequence blocks (see page 21, lines 1-10).

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***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lisimaque et al. as applied to claims 1 above, and further in view of McGauley et al. (US 5,899,998).

As per claim 4, although the system disclosed by Lisimaque et al. shows substantial features of the claimed invention (discussed above), it fails to disclose a server that includes means to back up (MSSEQ1,MSSEQ2) at least one sequence block (B) in the first memory (M1).

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Lisimaque et al., as evidenced by McGauley.

In an analogous art, McGauley discloses a portable data carrier such as a smart card that stores records (see column 2, lines 41-45). Further showing that it would have been obvious to have a server with a means to back up at least one sequence block in a memory (see Fig. 9, where data from a portable data carrier (PDC) is backed up onto a point of service (POS) station).

Given the teaching of McGauley, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Lisimaque et al. by employing a means to back up at least one sequence block in a memory, such as disclosed by McGauley, in order to have an updated record from a patient the next time they arrive at the doctors.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lisimaque et al. as applied to claim 1 above, and further in view of Drews et al. (US 5,467,081).

Although the system disclosed by Lisimaque et al. shows substantial features of the claimed invention (discussed above), it fails to disclose that the first memory (M1) includes a first area (Z1) and a

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second area (Z2), the first area (Z1) having read and write access by the server and read access by the card, the second area (Z2) having read and write access by the card.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Lisimaque et al., as evidenced by Drews et al.

In an analogous art, Drews et al. disclose a smart card with a first area and a second area, with the areas having the ability to control read and write access (see columns 1 and 2, lines 53-67 and 1-11).

Given the teaching of Drews et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Lisimaque et al by employing memory blocks with different read and write attributes, such as disclosed by Drews et al., in order to protect against illicit reading or writing.

13. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lisimaque et al. (WO 98/09257), and further in view of McGauley et al. (US 5,899,998).

As per claim 9, Lisimaque et al. further disclose a method to execute commands in a computer system including at least one server (SERV) and an integrated circuit card (CARD) connected together via a network, the said card including a first command execution program (P1) and a first memory (M1), as claimed, comprising:

- seeking each command sequence block (B) on the server (SERV) or in the memory (M1) [see page 21, lines 1-8, where it is implied that the card has to perform some kind of search operation to recognize if the application selected is not initialized or present; further application being located in non-volatile memory, page 10, lines 21-23],
- and, if the sequence block (B) sought is stored on the server (SERV), loading this block from the server (SERV) to the card (CARD) [see page 21, lines 18-21] to be executed using the said first program (P1) [see page 12, lines 4-9, where execution program is maintained by a virtual machine], or using a second program (P2) in a subscriber unit (SU connected to said card (CARD)).

Although the system disclosed by Lisimaque shows substantial features of the claimed invention (discussed above), it fails to disclose backing up all or some of the command sequence blocks specific to a service on at least one server (SERV).

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Lisimaque et al., as evidenced by McGauley.

In an analogous art, McGauley discloses a portable data carrier such as a smart card that stores records (see column 2, lines 41-45). Further showing that it would have been obvious to have a server with a means to back up at least one sequence block in a memory (see Fig. 9, where data from a portable data carrier (PDC) is backed up onto a point of service (POS) station).

Given the teaching of McGauley, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Lisimaque et al. by employing a means to back up at least one sequence block in a memory, such as disclosed by McGauley, in order to have an updated record from a patient the next time they arrive at the doctors.

As per claim 10, Lisimaque et al. further disclose backing up the said sequence block (B) from the server (SERV) in the memory (M1) [see Lisimaque et al. page 21, lines 18-21].

As per claim 11, Lisimaque et al. in view of McGauley further disclose updating in the first memory (M1), at least one command sequence block (B) specific to a service (S) [see Lisimaque et al. page 21, lines 18-21, where loading in an entire application implies at least one command sequence block].

As per claim 12, Lisimaque et al. in view of McGauley further disclose that the search for a sequence block on a server (SERV) consists of transmitting a data request (RD) from the card to a service server (see Lisimaque et al. pages 20 and 21, lines 21-23 and 1-21).

As per claim 13, Lisimaque et al. in view of McGauley further disclose interpreting in the card at least one command sequence block (B) before its execution (see Lisimaque et al. page 21, lines 1-10).

As per claim 14, Lisimaque et al. in view of McGauley further disclose that during the execution of a command (CD) of a sequence block (B) of receiving in the card memory (M1) at least one other command (CD) of the sequence block (see Lisimaque et al. page 21, lines 6-10).



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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J Chea whose telephone number is 571-272-3951. The examiner can normally be reached on M-F 7:00-4:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip J Chea  
Examiner  
Art Unit 2153

PJC 4/7/05

  
KRISNA LIM  
PRIMARY EXAMINER